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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,035

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Joseph J. Kubler

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MCANDREWS HELD & MALLOY, LTD  
500 WEST MADISON STREET  
SUITE 3400  
CHICAGO, IL 60661

EXAMINER

ROBERTS, BRIAN S

ART UNIT

PAPER NUMBER

2466

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/760,035	<b>Applicant(s)</b> KUBLER ET AL.	
	<b>Examiner</b> BRIAN ROBERTS	<b>Art Unit</b> 2466	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-30,32-34,36-38,54-59,78-86,93-122,124,126,128 and 130-149 is/are pending in the application.
- 4a) Of the above claim(s) 96-121 and 130-133 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-30,32-38,54-59,78-86,93-95,122,124,126,128 and 134-149 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

- Claims 22-30, 32-34, 36-38, 54-59, 78-86, 93-122, 124, 126, 128, and 130-149 remain pending.
- Claims 96-121 and 130-133 have been withdrawn.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 11/08/2010 has been entered.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented. Claim 31 is missing.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-30, 32-38, 54-59, 78-86, 93-95, 122, 124, 126, 128, and 134-149 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- In reference to claim 22, 30, 54

The limitation "identifying a second remote system accessible to the portable terminal device" in claim 22 line 14, and similarly in claim 30 line 13, 54 lines 5-6, and claim 54 line 6-7, was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Page 294 lines 3-13 of the specification describes a call request packet (*i.e. a request for information*). The call request packet contains an internal call routing field for storing the lowest cost routing pathway (along with its cost) which does not use an outgoing telephone line and an external call routing field for storing the lowest cost the lowest cost routing pathway (along with coast) utilizing an outgoing telephone line. However, the original disclosure fails to describe any fields of the call request packet or any request for information identifying a second remote system accessible to a portable terminal device. Thus, the limitation constitutes new matter.

- In reference to claim 78

The limitation "identifying a second remote system accessible to the at least one processor" in claim 78 line 6-7 was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Page 294 lines 3-13 of the specification describes a call request packet (*i.e. a request for information*). The call request packet contains an internal call routing field for storing the lowest cost routing pathway (along with its cost) which does not use an outgoing telephone line and an external call routing field for storing the lowest cost the lowest cost routing pathway (along with coast) utilizing an outgoing telephone line. However, the original disclosure fails to describe any fields of the call request packet or any request for information identifying a second remote system accessible to a portable terminal device. Thus, the limitation constitutes new matter.

- In reference to claim 23-29, 32-38, 55-59, 79-86, 93-95, 122, 124, 126, 128, 134-149

Claims 23-29, 32-38, 55-59, 79-86, 93-95, 122, 124, 126, 128, 134-149 are rejected because they depend on a rejected independent claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-30, 32-38, 122, 124, and 134-141 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In reference to claim 22

Claim 22 is directed to a portable terminal device (i.e. an apparatus). The language in lines 13-25 "wherein the portable terminal device transmits... call connection with the subscriber" renders the claim indefinite because it is unclear which structural component (*e.g. microphone converter, transmitter, receiver, transducer*) of the portable terminal device each of the wherein clauses is attempting to define. The claim should be amended to so that the functional language in lines 13-25 clearly defines a component of the portable terminal device.

- In reference to claim 30

Claim 30 is directed to a portable terminal device (i.e. an apparatus). The language in lines 12-24 "wherein the portable terminal device transmits... call connection with the subscriber" renders the claim indefinite because it is unclear which structural component (*e.g. microphone, converter, transmitter, receiver, transducer*) of the portable terminal device each of the wherein clauses is attempting to define. The claim should be amended to so that the functional

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language in lines 13-24 clearly defines a component of the portable terminal device.

- In reference to claim 23-29, 32-38, 122, 124, 134-141

Claims 23-29, 32-38, 122, 124, and 134-141 are rejected because they depend on a rejected independent claim.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN ROBERTS whose telephone number is (571)272-3095. The examiner can normally be reached on M-F 10:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DANIEL RYMAN can be reached on (571) 272-3152. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian Roberts/  
Examiner, Art Unit 2466  
02/13/2011